

REMARKS

Applicants thank the Examiner for the indication of allowable subject matter with respect to claims 15, 30 and 32-34. The present amendment is fully responsive to the Office Action having a mailing date of August 7, 2008. After entry of this amendment, claims 9, 11, 13-16 and 21-35 are pending in the Application. Claims 9 and 14 have been herein rewritten. New claim 35 has been added. No new matter has been added by this Amendment, and support for the claims, as amended may be found throughout the specification and drawings. At least for the reasons set forth below, Applicants respectfully traverse the foregoing rejections. Further, Applicants believe that there are also reasons other than those set forth below why the pending claims are patentable, and reserves the right to set forth those reasons, and to argue for the patentability of claims not explicitly addressed herein, in future papers.¹ Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicants expressly do not acquiesce to the taking of Official Notice, and respectfully request that the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 C.F.R. § 1.104(d)(2) and MPEP § 2144.03.

Applicants respectfully requests reconsideration of the present Application in view of the above amendments and the following remarks.

General Statement

The Examiner states that “[c]laims 9, 11, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2004/0077972 to Tsonton et al. in view of U.S. Patent No. 7,166,114 to Moctezuma De La Barrera et al.” (Office Action, page 2). The Examiner, however, fails to apply particular sections of the Tsonton et al. reference against each of the recitations in claims 9, 11, 13, 14 and 16. If the Examiner intends to maintain this rejection, Applicants respectfully request that the Examiner particularly identify passages in Tsonton et al. in the next office action which, in his view, allegedly read on the recitations in these claims, or otherwise withdraw the rejection.

¹ As Applicants’ remarks with respect to the Examiner’s rejections are sufficient to overcome these rejections, Applicants’ silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.

Claim Rejections – 35 U.S.C. § 103

I. Claims 9, 11, 13, 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsonton et al. (U.S. 2004/0077972) (“Tson-ton”) in view of Moctezuma De La Barrera et al. (U.S. 7,166,114) (“Moctezuma De La Barrera”).

A. Independent Claim 9

The rejection is respectfully traversed. The Examiner concedes that Tsonton fails to disclose guide locks slidably attached the indexing guide, and which selectively engage a portion of the medical instrument received within the receptacle. (Office Action, pg. 2). The Examiner contends, however, that a pair of spring loaded balls (122), as shown in Fig. 4 of Moctezuma De La Barrera, correspond to the guide locks recited in claim 9. Although Applicants do not acquiesce in the Examiner’s asserted basis for rejection, in the interest of moving prosecution forward, independent claim 9 has been rewritten to recite that the guide lock is moveable “between a locked position, in which the guide lock engages a portion of the medical instrument received within the receptacle ... and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle [emphasis added].” The cited references, taken singularly or in any permissible combination, do not anticipate, teach or suggest the claimed subject matter as recited in claim 9.

Indeed, as recited in claim 9, the guide lock can be disengaged from the medical instrument while the medical instrument is received in the receptacle. This cannot occur, however, with the spring loaded balls (122) in Moctezuma De La Barrera. The springs ensure that the balls remain in contact with the medical instrument while the medical instrument is disposed in the aperture of body (102). Further, the medical instrument completely blocks access to the balls, making it impossible to disengage the balls from the medical instrument so long as the medical instrument is attached to body (102). Consequently, the spring loaded balls (122), which the Examiner contends correspond to the “guide lock” of claim 9, cannot be “disengaged from the medical instrument received in the receptacle”. Thus, Applicants accordingly request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn with respect to claim 9 for at least the foregoing reasons.

B. Dependent Claim 14

The rejection with respect to claim 14 is respectfully traversed. The Examiner alleges that Tsonton discloses an indexing guide that includes “a lip adjacent the receptacle”. (Office Action, pg. 2). The Examiner, however, has failed to provide any indication whatsoever as to which portion of the device in Tsonton is alleged to correspond to the indexing guide having a lip, as recited in claim 14. Applicants have carefully reviewed Tsonton and have been unable to identify any feature that possibly may correspond to a lip positioned adjacent a receptacle, as recited in claim 14. Although Applicants do not acquiesce in the Examiner’s asserted basis for the rejection, in the interest of moving prosecution forward, claim 14 has been rewritten to further recite that the lip includes “a projection extending inward of the receptacle and engageable with the medical instrument.” In contrast, any feature in Tsonton that could arguably correspond to a lip positioned adjacent a receptacle, does not also include a projection extending inward of the receptacle and engageable with the medical instrument. Thus, Applicants accordingly request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn with respect to claim 14 for at least the foregoing reasons.

C. Dependent Claims 11, 13 and 16

The rejection with respect to claims 11, 13 and 16 is respectfully traversed. Claims 11, 13 and 16 depend directly from claim 9. The same arguments made above with respect to independent claim 9 are equally applicable to dependent claims 11, 13 and 16. Accordingly, it is respectfully requested that the rejection of claims 11, 13 and 16 under 35 U.S.C. § 103(a) be reconsidered and withdrawn for at least the foregoing reasons.

II. Claims 9, 14 and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Warner et al. (U.S. 5,871,487) (“Warner”) in view of Moctezuma De La Barrera et al. (U.S. 7,166,114) (“Moctezuma De La Barrera”).

A. Independent Claim 9

The rejection is respectfully traversed. The Examiner concedes that Warner fails to disclose a guide lock that is “moveable axially through application of an axial force to the guide

lock.” (Office Action, pg. 4). The Examiner alleges, however, that a pair of spring loaded balls (122), as shown in Fig. 4 of Moctezuma De La Barrera, correspond to the guide lock recited in claim 9. Although Applicants do not acquiesce in the Examiner’s asserted basis for rejection, in the interest of moving prosecution forward, independent claim 9 has been rewritten to recite that the guide lock is moveable “between a locked position, in which the guide lock engages a portion of the medical instrument received within the receptacle ... and an unlocked position, in which the guide lock is disengaged from the medical instrument received in the receptacle [emphasis added].” In contrast, the cited references, taken singularly or in any permissible combination, do not anticipate, teach or suggest the claimed subject matter as recited in claim 9.

As recited in claim 9, the guide lock can be disengaged from the medical instrument while the medical instrument is received in the receptacle. As discussed above, this cannot occur, however, with the spring loaded balls (122) in Moctezuma De La Barrera. The springs ensure that the balls remain in contact with the medical instrument while the medical instrument is disposed in the aperture of body (102). Further, the medical instrument completely blocks access to the balls, making it impossible to disengage the balls from the medical instrument so long as the medical instrument is attached to body (102). Consequently, the spring loaded balls (122), which the Examiner contends corresponds to the “guide lock” of claim 9, cannot be “disengaged from the medical instrument received in the receptacle”. Thus, Applicants accordingly request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn with respect to claim 9 for at least the foregoing reasons.

B. Dependent Claim 14

The rejection with respect to claim 14 is respectfully traversed. The Examiner alleges that Warner discloses an indexing guide that includes “a lip adjacent the receptacle”. (Office Action, pg. 3). Although Applicants do not acquiesce in the Examiner’s asserted basis for rejection, in the interest of moving prosecution forward, claim 14 has been rewritten to further recite that the lip includes “a projection extending inward of the receptacle and engagable with the medical instrument.” In contrast, the alleged “lip” in Warner does not include a projection extending inward of the receptacle and engagable with the medical instrument. Thus, Applicants accordingly request that the rejection under 35 U.S.C. § 103(a) be reconsidered and withdrawn with respect to claim 14 for at least the foregoing reasons.

C. Dependent Claims 21-24

The rejection with respect to claims 21-24 is respectfully traversed. Claims 21-24 depend either directly or indirectly from claim 9. The same arguments made above with respect to independent claim 9 are equally applicable to dependent claims 21-24. Accordingly, it is respectfully requested that the rejection of claims 21-24 under 35 U.S.C. § 103(a) be reconsidered and withdrawn for at least the foregoing reasons.

III. Claims 25-29 and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Warner et al. (U.S. 5,871,487) (“Warner”) in view of Moctezuma De La Barrera et al. (U.S. 7,166,114) (“Moctezuma De La Barrera”), and further in view of Bodendieck et al. (DE 935,625) (“Bodendieck”). The rejection is respectfully traversed. Claims 25-29 and 31 depend either directly or indirectly from claim 9. The same arguments made above with respect to independent claim 9 are equally applicable to dependent claims 25-29 and 31. Accordingly, it is respectfully requested that the rejection of claims 25-29 and 31 under 35 U.S.C. § 103(a) be reconsidered and withdrawn for at least the foregoing reasons.

New Claims

New claim 35 has been added in this Amendment for the Examiner’s consideration. new claim 35 depends from claim 14. Support for new claim 35 may be found in at least paragraph [0035] and Figs. 11 and 12 of the Application as originally filed. The cited references, whether taken singularly or in any permissible combination, do not anticipate, teach or suggest the subject matter recited in new claim 35. The Examiner’s consideration of new claim 35 is respectfully requested.

CONCLUSION

All rejections have been addressed. In view of the above, the pending claims are believed to be in condition for allowance over the cited prior art. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they

Application No.: 10/803,698
Amendment dated October 10, 2008
Office Action of August 7, 2008

Docket No.: 65937-0047

may be charged to Deposit Account 18-0013, under Order No. 65937-0047 from which the undersigned is authorized to draw. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

Dated: October 10, 2008

Respectfully submitted,

Electronic Signature: /Daniel J. Checkowsky/
Kristin L. Murphy
Registration No. 41,212
Daniel J. Checkowsky
Registration No. 51,549
RADER, FISHMAN & GRAUER PLLC
Correspondence Customer Number: 10291
Attorneys for Applicants

R0473708.DOC